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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERENCE EDWIN DODGSON and CHARLES TIBENDERANA

Appeal 2009-003826
Application 10/648,560
Technology Center 2600

Decided: April 13, 2010

Before JOSEPH F. RUGGIERO, MARC S. HOFF, and KARL D.
EASTHOM, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1-18, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed January 9, 2008), the Answer (mailed March 31, 2008), and the Reply Brief (filed May 30, 2008) for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived (*see* 37 C.F.R. § 41.37(c)(1)(vii) (2008)).

Appellants' Invention

Appellants' invention relates to a modulating device for modulating and demodulating data transmitted from a first device to a second device. The modulating device is capable of modulating and demodulating the data according to at least first and second modulation techniques and further includes a switch for automatically switching between the at least first and second modulation techniques. (*See generally* Spec. 3:11-23).

Claim 1 is illustrative of the invention and reads as follows:

1. A modulating device for modulating and demodulating data for transmission from a first device to a second device, comprising modulating means capable of modulating and demodulating the data according to at least a first and a second modulation technique using common digital modulation components, and a switching means for automatically switching between at least the first and the second modulation techniques.

The Examiner's Rejections

The Examiner relies on the following prior art to show unpatentability:

Womack	US 5,982,819	Nov. 9, 1999
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Admitted Prior Art (APA) at pages 1 and 2 of Appellants' Specification.

Claims 1, 2, 17, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Womack.

Claims 3-16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Womack in view of APA.

ISSUE

The pivotal issue before us is whether the Examiner erred in determining that the messaging system of Womack, which is capable of handling communications with different modulation formats, *inherently* includes a mechanism for automatically switching between a first modulation technique and a second modulation technique as claimed.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Womack discloses (Fig. 1, col. 2, l. 63-col. 3, l. 4) a messaging receiver which is adaptable to a plurality of modulation formats. A plurality of transmitters 111 are controlled by a system controller 107 to transmit message suitable for reception by a Personal Messaging Unit (PMU) 113.

2. Womack further discloses (col. 3, ll. 4-16) that the messaging receivers 115, 117 include flexible resources which are configured in accordance with a particular modulation format.

3. Womack also discloses (col. 2, ll. 26-40) that the PMUs 113 can receive multiple modulation formats on the forward channel 103 and can transmit on the plurality of modulation formats on the reverse channel 105.

4. Womack further discloses (col. 7, ll. 9-28) that the receivers 1115, 117, upon notification of a particular modulation technique, will allocate their flexible resources to receive and demodulate the reverse channel response from the PMUs 113.

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder*

Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Furthermore,

[“]there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(b) REJECTION

Appellants' arguments with respect to independent claims 1, 17, and 18 focus on the contention that, in contrast to the claimed invention, Womack does not disclose a switching means for automatically switching between first and second modulating techniques. According to Appellants (App. Br. 5-6; Reply Br. 2-3), while the Examiner has asserted that a modulation technique switching operation, which is admittedly not disclosed in Womack, is nevertheless inherent, the Examiner has provided no support for such a determination. In Appellants' view (*id.*), while Womack's disclosed messaging system may have the capability of handling different modulation types, it does not necessarily follow that such a system would have a means for automatically switching from one modulation format to another as claimed.

We agree with Appellants. We find no basis in fact and/or technical reasoning from the Examiner that would establish that, merely because a system can accommodate different modulation formats, it would *necessarily* follow that there must be some mechanism to switch between formats, let alone *automatically* switch as required by Appellants' claims. While the Examiner maintains (Ans. 5, FF 1-2) that, since Womack's messaging system is disclosed as accommodating communications from personal messaging units (PMUs) operating with different modulation formats, there is a clear implication that there must be a capability to switch automatically from one modulation format to another, we find this to be speculative.

The Examiner's conclusion does indicate that the system in Womack could function as the Examiner has alleged, perhaps even how it could

obviously perform, but it does not follow that the system of Womack *must* function in such a fashion or would *necessarily* function that way inherently. “[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account.” *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985).

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Womack, we do not sustain the Examiner’s 35 U.S.C. § 102(b) rejection of independent claims 1, 17, and 18, nor of claim 2 dependent thereon.

35 U.S.C. § 103(a) REJECTION

We also do not sustain the Examiner’s obviousness rejection of dependent claims 3-16 based on the combination of Womack and APA. The Examiner has applied APA to Womack to address, *inter alia*, the programmable finite impulse response filter feature of these claims. We find nothing in the disclosure of APA, however, which overcomes the innate deficiencies of Womack discussed *supra*.

CONCLUSION

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 1, 2, 17, and 18 for anticipation under 35 U.S.C. § 102(b), and in rejecting claims 3-16 for obviousness under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision rejecting claims 1, 2, 17, and 18 under 35 U.S.C. § 102(b) and claims 3-16 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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